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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
	:	
Hendra SUWANDA, et al.	:	Confirmation Number: 7250
	:	
Application No.: 09/998,347	:	Group Art Unit: 3691
	:	
Filed: November 30, 2001	:	Examiner: B. Shrestha
	:	
For: CONTRACT-BASED ELECTRONIC CATALOGS	:	

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed September 12, 2007, wherein Appellants appeal from the Examiner's rejection of claims 1-17 and 20.

I. REAL PARTY IN INTEREST

This application is assigned to IBM Corporation by assignment recorded on December 10, 2001, at Reel 012345, Frame 0807.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1-17 and 20 are pending and two-times rejected in this Application. Claims 18 and 19 have been cancelled. It is from the multiple rejections of claims 1-17 and 20 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

The claims have not been amended subsequent to the imposition of the Second and Final Office Action dated September 7, 2007 (hereinafter the Second Office Action).

V. SUMMARY OF CLAIMED SUBJECT MATTER

1 Referring to Figures 1 and 2 and also to independent claim 1, a computer system is
2 disclosed. The computer system defines a set of electronic catalogs 32, 34 for a defined product
3 universe. Each of the catalogs in the set have an associated contract (page 6, lines 20-23). Each
4 of the users of the electronic each are associated with one of the contracts (page 6, lines 23-25).
5 Each catalog has a unique catalog identifier (page 6, lines 10-12, 19), and each contract has a
6 unique contract identifier (page 6, line 18). A graph (page 6, lines 20-21) representing the
7 electronic catalogs is generated, stored, and maintained. Each node in the graph contains data,
8 and each edge in the graph connects two nodes and is associated with one or more catalog or
9 contract identifiers (page 6, line 28 through page 7, line 1). The graph is traversed in response to
10 user requests, and the traversal of the graph is constrained by the catalog or contract identifiers
11 associated with the edges in the graph (page 8, lines 9-10). The data at the reached nodes in the
12 traversal of the graph is displayed to the user (page 8, lines 10-13).

1 Referring to Figures 1 and 2 and also to independent claim 11, a method is disclosed.
2 The method defines and displays a set of electronic catalogs 32, 34 for a defined product
3 universe. Each of the catalogs in the set have an associated contract (page 6, lines 20-23). Each
4 of the users of the electronic each are associated with one of the contracts (page 6, lines 23-25).
5 Each catalog has a unique catalog identifier (page 6, lines 10-12, 19), and each contract has a
6 unique contract identifier (page 6, line 18). A graph (page 6, lines 20-21) representing the
7 electronic catalogs is generated, stored, and maintained. Each node in the graph contains data,
8 and each edge in the graph connects two nodes and is associated with one or more catalog or
9 contract identifiers (page 6, line 28 through page 7, line 1). The graph is traversed in response to
10 user requests, and the traversal of the graph is constrained by the catalog or contract identifiers
11 associated with the edges in the graph (page 8, lines 9-10). The data at the reached nodes in the
12 traversal of the graph is displayed to the user (page 8, lines 10-13).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-10 were rejected under the first paragraph of 35 U.S.C. § 112; and
2. Claims 1-17 and 20 were rejected under 35 U.S.C. § 102 for anticipation based upon Hare et al., U.S. Patent No. 6,850,900 (hereinafter Hare).

VII. ARGUMENT

THE REJECTION OF CLAIMS 1-10 UNDER THE FIRST PARAGRAPH OF 35 U.S.C. § 112

For convenience of the Honorable Board in addressing the rejections, claims 2-10 stand or fall together with independent claim 1.

On page 3 of the First Office Action, the Examiner asserted that the claimed invention, as recited in claims 1-10, contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. Specifically, the Examiner asserted the following:

Claims 1-10 recite various means and steps of performing the recited claims which is shown by flow charts but fails point out how it is implemented by system. The applicant fails to present "the computer system" to implement the recited claims.

In the First Amendment dated May 29, 2007, Appellants responded by noting that the Examiner's assertion stretches believability. In particular, the Examiner is apparently asserting that one having ordinary skill in the art would not know what a computer system is or how a computer system works.

Figure 1 of Appellants' disclosure is described as a UML diagram. As is well-known in the art, UML (Unified Modeling Language)¹ is a standardized language for modeling software, and the use of UML diagrams is very commonly known as a part of UML. Thus, based upon the UML diagram in Figure 1 of Appellants' disclosure, Appellants' position is that one having ordinary skill in the art would have been able to make and/or use the claimed invention.

¹ http://en.wikipedia.org/wiki/Unified_Modeling_Language.

1 In the Second Office Action, the Examiner did not directly address Appellants' prior
2 arguments. Instead, the Examiner asserted the following in the first full paragraph on page 3:

3 Claims 1-10 recite various means and steps of performing the recited claims which is
4 shown by flow charts but fails point out how it is implemented by system. The applicant fails to
5 illustrate "the computer system" to implement the recited claims, The Examiner maintains that one
6 of ordinary skill in art would not know how computer system is used in contract-based electronic
7 catalogs as claimed by the Applicant. (emphasis in original)
8

9 Appellants are still unclear as to why the Examiner believes why one having ordinary skill in the
10 art would know how to make and/or use the claimed invention. The Examiner's argument is
11 merely a generalization without any specifics.
12

13 The use of computer systems with electronic catalogs long predates the filing date of the
14 present application.² Regarding "contract-based electronic catalogs," the use of contracts (i.e., an
15 agreement between two parties, e.g., a buyer and seller; see also discussion on page 1 of
16 Appellants' disclosure) with catalogs (either electronic or not) has also been well known. Thus,
17 Appellants maintain their position that one having ordinary skill in the art would have been able
18 to make and/or use the claimed invention.
19

20 **THE REJECTION OF CLAIMS 1-17 AND 20 UNDER 35 U.S.C. § 102 FOR ANTICIPATION**
21 **BASED UPON HARE**

22 For convenience of the Honorable Board in addressing the rejections, claims 4-11, 14-17
23 and 20 stand or fall together with independent claim 1; claim 12 stands or fall together with
24 dependent claim 2; and dependent claim 13 stands or falls together with dependent claim 3.
25

26 As is evident from Appellants' previously-presented comments during prosecution of the

² See, e.g., the discussion at http://www.marcole.com/gift_registry/company/company_01a.html.

present Application and from Appellants' comments below, there are questions as to how the limitations in the claims correspond to features in the applied prior art. In this regard, reference is made to M.P.E.P. § 1207.02, entitled "Contents of Examiner's Answer." Specifically, the following is stated:

(A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

...

(9)(e) For each rejection under 35 U.S.C. 102 or 103 where there are questions as to how limitations in the claims correspond to features in the prior art even after the examiner complies with the requirements of paragraphs (c) and (d) of this section, the examiner must compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison must align the language of the claim side-by-side with a reference to the specific page, line number, drawing reference number, and quotation from the prior art, as appropriate. (emphasis added)

Therefore, if the Examiner is to maintain the present rejections and intends to file an Examiner's Answer, the Examiner is required to include the aforementioned section in the Examiner's Answer.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.³ Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.⁴ As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify

³ *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

⁴ See *In re Spada*, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

corresponding elements disclosed in the allegedly anticipating reference.⁵ This burden has not been met.

Appellants' Prior Arguments

On pages 11-13 of the First Office Action, Appellants' presented the following arguments. To teach the claimed "means for generating, storing and maintaining a graph representing the electronic catalogs," the Examiner cited Fig. 5, Figs. 7A-C, and column 16, lines 16-28 of Hare. However, upon reviewing these figures and the Examiner's cited passage, Appellants have been unable to find this teaching. For ease of reference, column 16, lines 16-28 is reproduced below:

The content management application 18 also provides a plurality of interfaces which enable the supplier's contract manager to create general catalogs for buyers and specifically general catalogs for contracts with specific buyers. The system provides: (a) a general catalog-select items interface as illustrated in FIG. 7A which enables the supplier contract manager to select items for inclusion in the general catalog; (b) a general catalog-select items interface as illustrated in FIG. 7B which enables the supplier to include the selected items in the general catalog; and (c) a general catalog-naming interface as illustrated in FIG. 7C which enables the supplier to name the general catalog.

This passage fails to teach the claimed limitations as to several aspects. The claims recite "a graph" (i.e., a single graph as subsequent limitations refer to the graph) being used to represent "the electronic catalogs" (i.e., a plurality of catalogs). However, what is described by Hare refers to a single catalog (i.e., the "general catalog"). Moreover, the claims recite "a graph representing the electronic catalogs." What is illustrated in Figs. 7A-7C is not a graph. Furthermore, the claim recites "storing and maintaining a graph," yet Figs. 7A-7C are described as "general catalog creation interfaces." As is common in the art, the interfaces are recreated each time they

⁵ Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

1 are generated and not stored and maintained, as claimed. Thus, the Examiner has failed to
2 establish that Hare identically discloses these further limitations.

3
4 To teach the claimed "each node in the graph containing data," the Examiner cited Figs.
5 11A-Q, Figs. 12A-J, and Figs. 15A-G. However, upon reviewing these figures, Appellants note
6 that these figures describe several different interfaces. Thus, not only are these interfaces not
7 graphs, as claimed, these interfaces are not a single graph, as claimed. Thus, the Examiner has
8 failed to establish that Hare identically discloses these further limitations.

9
10 To teach the claimed "each edge in the graph connecting two nodes and being associated
11 with one or more catalog or contract identifiers," the Examiner cited Figs. 11J, 11L, Fig. 12C,
12 Fig. 12D, and Fig. 12E. Appellants are entirely unclear why the Examiner is citing these figures.
13 These figures illustrate interfaces, not a graph, as claimed.

14
15 To teach the claimed "means for traversing the graph in response to user requests, the
16 traversal of the graph being constrained by the catalog or contract identifiers associated with the
17 edges in the graph," the Examiner cited Fig. 1 and columns 16-35 of Hare. It is readily apparent
18 that the Examiner has no idea where Hare teaches this limitation, since the Examiner cited 20
19 columns of text for a limitation that is only 30 words long. In this regard, the Examiner's
20 rejection under 35 U.S.C. § 102 also fails to comply with 37 C.F.R. § 1.104(c), which reads:

21 In rejecting claims for want of novelty or for obviousness, the examiner must cite the best
22 references at his or her command. When a reference is complex or shows or describes inventions
23 other than that claimed by the applicant, the particular part relied on must be designated as nearly
24 as practicable. The pertinence of each reference, if not apparent, must be clearly explained and
25 each rejected claim specified.
26

1 The manner in which the Examiner conveyed the statement of the rejection, which is to
2 cite 20 columns of text, has not "designated as nearly as practicable" the particular parts in Hare
3 being relied upon in the rejection.

4
5 Examiner's Response

6 On page 13 of the Second Office Action, the Examiner responded to Appellants' prior
7 arguments as follows:

8 The Applicant further argues that claim recited "a graph" to represent "electronic
9 catalogs" rather than a single catalog referred by Hare et al. and reference Fig. 7A-C is not a
10 graph. As per reference of **dictionary.com**, graph has been defined as "a diagram representing a
11 system of connections or interrelations among two or more things by a number of distinctive dots,
12 lines, bars, etc". As can be seen from Fig. 7A-C, these display could be represented in graphical
13 form by connecting by lines; these Figures shows interrelationship among two or more things, for
14 example catalogue TPN (16378) and abrasives, batteries and bearings etc. Similarly, Fig. 11 J and
15 11L were cited to show how contract 0020 (edge) contains contract catalogs (nodes) gc-sabs-0600,
16 cabinet, ms-cabinets and scott.
17

18 The issue of claim construction is discussed in M.P.E.P. § 2111, entitled "Claim
19 Construction; Broadest Reasonable Interpretation," a portion of which is reproduced below:

20 During patent examination, the pending claims must be "given their broadest reasonable
21 interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d
22 1664, 1667 (Fed. Cir. 2000) ... The broadest reasonable interpretation of the claims must also be
23 consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165
24 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).
25

26 The Examiner's "interpretation," however, is both unreasonable and not consistent with
27 Appellants' specification. A saying, heard occasionally in patent circles, is "just because you
28 could put your shoe on your head doesn't make it a hat." Similarly, just because "these display
29 could be represented in graphical form by connecting by lines," as asserted by the Examiner,
30 does not make the interfaces within Hare a graph corresponding to that claimed. Moreover, as
31 noted above, anticipation requires identical disclosure, which is different that "what if"

disclosure (i.e., what if these displays were represented in graphical form?). As an aside, Appellants also note that being "graphical" does not necessarily equate to be a "graph."

Claim 2

The Examiner's cited passages fails to identically disclose contract nodes, catalog nodes, category nodes, product nodes and price nodes in the graph (i.e., a single graph). Instead, the Examiner cites to at least 5 different user interfaces, and not a graph, as claimed.

Claim 3

The Examiner's cited passages fails to identically disclose an edges notwithstanding that particular edges are associated with contract and catalog identifiers.

Conclusion

Based upon the foregoing, Appellants respectfully submit that the Examiner's rejections under 35 U.S.C. §§ 102, 112 is not viable. Appellants, therefore, respectfully solicit the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. §§ 102, 112.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: February 7, 2008

Respectfully submitted,

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CUSTOMER NUMBER 46320

VIII. CLAIMS APPENDIX

1. A computer system for defining a set of electronic catalogs for a defined product universe, each of the catalogs in the set having an associated contract, users of the electronic catalogs each being associated with one of the contracts, each catalog having a unique catalog identifier and each contract having a unique contract identifier, the computer system comprising

means for generating, storing and maintaining a graph representing the electronic catalogs,

each node in the graph containing data and

each edge in the graph connecting two nodes and being associated with one or more catalog or contract identifiers,

means for traversing the graph in response to user requests, the traversal of the graph being constrained by the catalog or contract identifiers associated with the edges in the graph, and means for displaying to the user the data at reached nodes in the graph traversal.

2. The computer system of claim 1 in which the nodes comprise contract nodes, catalog nodes, category nodes, product nodes and price nodes, in which

child nodes for contract nodes comprise catalog nodes,

a catalog node may have alternatively, child category nodes or child product nodes,

child nodes for category nodes comprise product nodes,

child nodes for product nodes comprise price nodes, and

in which each parent node has a potential plurality of child nodes.

3. The computer system of claim 2 in which

each edge between a contract node and a catalog node is associated with a contract identifier,

each edge between a catalog node and a category node is associated with a catalog identifier,

each edge between a category node and a product node is associated with a catalog identifier and

each edge between a product node and a price node is associated with a contract identifier.

4. The computer system of claim 3 in which the means for traversing the graph comprises means for traversing an edge in response to a user request only when either the contract identifier for the contract with which a user is associated or the catalog identifier for the catalog with which the user's contract is associated matches the identifier associated with that edge in the graph.

5. The computer system of claim 2 in which each contract node comprises associated contract information and time interval attributes, each product node comprises an associated product identifier attribute, and each price node comprises associated amount, currency and effective date attributes.

6. The computer system of claim 1 in which the graph is represented by a relational database table.

7. The computer system of claim 2 in which a catalog node may have child catalog nodes.

8. The computer system of claim 2 in which a category node may have child category nodes and in which each edge between a category node and a category node is associated with a catalog identifier.

9. The computer system of claims 1, 2, 3 or 4 further comprising a graphical user interface tool for presenting a master catalog to a catalog author and for permitting the catalog author to filter the nodes and edges in the master catalog and to define new nodes and edges to create a new catalog.

10. A computer program product for defining a set of electronic catalogs, the computer program product comprising a computer usable medium having computer readable code means embodied in said medium, and comprising computer readable program code means for implementing the computer system of claims 1, 2, 3, 4, 5, 6, 7 or 8.

11. A method for defining and displaying a set of electronic catalogs for a defined product universe, each of the catalogs in the set having an associated contract, users of the electronic catalogs each being associated with one of the contracts, each catalog having a unique catalog identifier and each contract having a unique contract identifier, the method comprising the following steps:

generating, storing and maintaining a graph representing the electronic catalogs,
each node in the graph containing data and
each edge in the graph connecting two nodes and being associated with one or more catalog or contract identifiers,
traversing the graph in response to user requests, the traversal of the graph being constrained by the catalog or contract identifiers associated with the edges in the graph, and displaying to the user the data at reached nodes in the graph traversal.

12. The method of claim 11 in which the nodes comprise contract nodes, catalog nodes, category nodes, product nodes and price nodes, in which
child nodes for a contract node comprise catalog nodes,
a catalog node may have alternatively, child category nodes or child product nodes,
child nodes for category nodes comprise product nodes,
child nodes for product nodes comprise price nodes, and
in which each parent node has a potential plurality of child nodes.

13. (Currently Amended) The method of claim 12 in which
each edge between a contract node and a catalog node is associated with a contract identifier,
each edge between a catalog node and a category node is associated with a catalog identifier,
each edge between a category node and a product node is associated with a catalog identifier and

each edge between a product node and a price node is associated with a contract identifier.

14. The method of claim 13 in which the step of traversing the graph comprises the step of comparing the contract identifier for the contract with which a user is associated or the catalog identifier for the catalog with which the user's contract is associated and the identifier associated with a reached edge in the graph and further comprises the step of traversing that reached edge only when the comparison shows a match condition.

15. A computer program product for defining and displaying a set of electronic catalogs, the computer program product comprising a computer usable medium having computer readable code means embodied in said medium, comprising computer readable program code means for carrying out the method of claims 11, 12, 13, or 14.

16. The computer program product of claim 15 wherein said computer readable code means comprises a computer readable signal and said medium comprises a computer readable signal-bearing medium.

17. The program product of claim 16 wherein said medium is a recordable data storage medium.

20. A computer program comprising computer program code means adapted to perform all the steps of claims 11, 12, 13, or 14 when said program is run on a computer system.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellants in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellants are unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.